

REMARKS

Applicants have carefully reviewed this Application in light of the Final Office Action mailed December June 2, 2005. Claims 1-34 are pending in this Application. Claims 1-34 stand rejected under 35 U.S.C. §103. Applicants respectfully request reconsideration and favorable action in this case.

Rejections under 35 U.S.C. §103

Claims 1-34 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,103,427 issued to Glen Edward Storm ("*Storm*") in view of U.S. Patent No. 6,555,079 issued to Jeffery B. Hoke et al. ("*Hoke*"). Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Furthermore, according to § 2143 of the Manual of Patent Examining Procedure, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Applicants submit that it would not have been obvious to one skilled in the art to make the proposed combinations of references. The mere fact that references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). The showing must be clear and particular. *See, e.g., C.R. Bard v. M3 Sys., Inc.*, 48 USPQ.2d 1225, 1232 (Fed. Cir. 1998). In the Office Action, the Examiner relies on *Storm* as the primary reference

and *Hoke* as a secondary reference with respect to all claims. With respect to all claims, the Examiner speculates that

It would have been obvious to one having ordinary skill in the art to take the teachings of *Storm* and combine them with the teachings of *Hoke et al.* in order to make the claimed invention because the use of molecular sieve for adsorbing AMCs is well known in any art which requires a gas vacuum or pressure differential across a membrane to be maintained, or requires the residual air environment to be free of these contaminants and they are also used in the clean room environments in which the masks pellicle assemblies are made.

(Office Action, page 5). Applicants respectfully submit, however, that one of ordinary skill in the art at the time of the invention would not have been motivated to make the proposed combination.

It is essential to view the invention as a whole, taking each element into account as well as the advantages, properties, utilities, and results of the invention. *In re Chupp*, 816 F.2d 643, 2 U.S.P.Q.2d 1437 (Fed. Cir. 1987). The very principle and purpose of the pellicle disclosed in *Storm* is to cover a pattern on a photomask. (Col. 2, Lines 13-15). Additionally, the pellicle and photomask are typically manufactured and used in a "clean room" facility (e.g., a facility in which ambient particle concentration is measurably reduced). (Col 2, Line 66 to Col. 3, Line 4). *Hoke*, on the other hand, discloses an adsorbent that may be formed on a surface of a radiator of a motor vehicle to remove pollutants contained in the atmosphere. (Col. 3, Lines 9-16). Thus, the references propose very different solutions to very different problems. Furthermore, there is no explicit or implicit reference in either reference which would suggest to one of ordinary skill to combine the pellicle of *Storm* with the adsorbent composition of *Hoke*. In this respect, Applicants respectfully submit that the references are non-analogous art and, because not related, are an improper combination.

Furthermore, it is improper for an Examiner to use hindsight having read the Applicants' disclosure to arrive at an obviousness rejection. *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). It is improper to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). The inconsistent objectives and the results obtained by the systems of

Storm and *Hoke*, as identified by Applicants above, evidences the Examiners reconstruction of Applicants' claims by using hindsight to piece together disjointed portions of inconsistent references.

For at least these reasons, Applicants respectfully submit that the proposed *Storm-Hoke* combination is improper. Accordingly, the rejection of Applicants' claims over the proposed *Storm-Hoke* combination should be withdrawn.

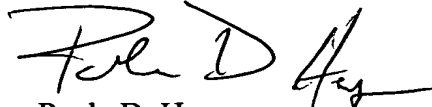
CONCLUSION

Applicants appreciate the Examiner's careful review of the application. Applicants have now made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. For the foregoing reasons, Applicants respectfully request reconsideration of the rejections and full allowance of Claims 1-34, as amended.

Applicants believe there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2581.

Respectfully submitted,
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Date: Sept. 2, 2005

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